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Paper No. 14  
ejs

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Leisure Lawn, Inc.

Serial No. 75/799,847

B. Joseph Schaeff, Killworth, Gottman, Hagan & Schaeff,  
L.L.P. for Leisure Lawn, Inc.

Nicholas K. D. Altree, Trademark Examining Attorney, Law  
Office 109 (Ronald R. Sussman, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Leisure Lawn, Inc. has appealed from the final refusal of the Examining Attorney to register PERIMETER PEST PROTECTION as service mark for "insect and pest control."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark PERIMETER,

previously registered for insecticides,<sup>2</sup> that, when used on applicant's identified services, is likely to cause confusion or mistake or to deceive. The Examining Attorney has also made final, pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. 1056(a), a requirement that applicant disclaim exclusive rights to the words PEST PROTECTION.

Both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We affirm the refusal and the requirement for disclaimer.

We turn first to the requirement for a disclaimer. Section 6(a) of the Trademark Act provides, in part, that the Director may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) of the Act prohibits the registration of a mark which is merely descriptive of the applicant's goods.

Applicant does not dispute that the words PEST PROTECTION are merely descriptive of its services,<sup>3</sup> and

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<sup>1</sup> Application Serial No. 75/799,847, filed September 15, 1999, and asserting first use and first use in commerce as early as 1994.

<sup>2</sup> Registration No. 1,485,002, issued April 19, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>3</sup> In its brief, at p. 4, applicant makes the statement that its "continuous use of the PERIMETER PEST PROTECTION mark in connection with its insect and pest control services for over five years suggests that purchasers have come to recognize

indeed, the record supports the Examining Attorney's position. Rather, applicant contends that PEST PROTECTION need not be disclaimed because the words are part of a unitary mark, PERIMETER PEST PROTECTION. Applicant bases this position on the fact that each word in the mark begins with the same letter and sound, and this alliteration "encourages consumers to view the phrase as a unitary whole rather than as a collection of separate terms." Brief, p. 4.

In **Dena Corporation v. Belvedere International, Inc.**, 950 F.2d 1555; 21 USPQ2d 1047, 1052 (Fed. Cir. 1991), the Court of Appeals for the Federal Circuit stated that:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression. This test for unitariness requires the Board to determine "how the average purchaser would encounter the mark under normal marketing of such goods and also...what the reaction of the average purchaser

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Applicant's mark as a unitary expression signifying the source of those insect and pest control services." We do not view this statement as a claim that PEST PROTECTION is not merely descriptive because the mark as a whole has acquired distinctiveness. Applicant did not make a Section 2(f) claim during the prosecution of its application and, moreover, it is clear that applicant's reference to its use is in support of its contention that its mark is a unitary term.

would be to this display of the mark." Magic Muffler, 184 USPQ at 126. The Trademark Manual of Examining Procedure (TMEP) sets forth several factors to assist in making this determination: whether it is physically connected to the mark by lines or other design features; how close the matter is located to the mark and whether side by side on the same line; the meaning of the words and how the meaning relates to each other and to the goods....TMEP § 807.13(a) (rev. 1986).

Using these guidelines, we find that PERIMETER PEST PROTECTION is not a unitary mark. Although each element of the mark does begin with the letter "P", the phrase PEST PROTECTION remains a separable element from the word PERIMETER. It is even visually separated in the most prominent usages of the mark in applicant's specimens, with the word PERIMETER depicted in a substantially larger size than the words PEST PROTECTION, and on a separate line, from the latter two words. Therefore, consumers are not likely to view the entire phrase as a unitary whole.

Moreover, the term PEST PROTECTION is used by others in connection with pest control, such as in advertisements by third parties and in newspaper articles. See, for example:

AL HOFFER'S PEST PROTECTION, INC.  
We are South Florida termite and pest  
control company. We specialize in  
control of termites, roaches ants,  
fleas and other insects. Al Hoffer's

Pest Projection Inc. has been family owned and operated for 25 years.

[www.alhoffers.com](http://www.alhoffers.com)

NEW TECH PEST CONTROL  
Billerica's Oldest Family Owned Pest  
Control Company

[lists] Pest Protection Plans

[www.newtechpest.com](http://www.newtechpest.com)

Standard features: Concrete block  
construction, concrete walks, drive and  
patio, termite and pest protection  
systems, antique brass door  
hardware....

"The Orlando Sentinel," March 21, 2000

As a result, consumers will view PEST PROTECTION as a  
separable element in the mark PERIMETER PEST PROTECTION.

Put simply, PEST PROTECTION retains its descriptive  
meaning when it is combined with the word PERIMETER.

This situation is distinguishable from that in **In re Kraft, Inc.**, 218 USPQ 571 (TTAB 1983), upon which applicant  
relies. In that case, the Board found LIGHT 'N LIVELY to  
be a unitary mark, such that a disclaimer of LIGHT was not  
required, because the mark as a whole "has a suggestive  
significance which is distinctly different from the merely  
descriptive significance of the term 'LIGHT' per se."

Although the Board went on to note that "the expression as  
a whole has an alliterative lilting cadence which  
encourages persons encountering it to perceive it as a  
whole," the alliteration of the mark was not the sole basis

for finding it to be unitary. Moreover, in a subsequent decision involving a mark with alliteration, LEAN LINE, the Board distinguished Kraft, explaining that LEAN LINE" is not an expression, like LIGHT 'N LIVELY or SUGAR & SPICE [held not merely descriptive of bakery products in **In re Colonial Stores Inc.**, 394 F 2d. 549, 157 USPQ 382 (CCPA 1968)], which has any known use or application apart from the goods in question. The Board indicated that something more than the mere fact that both words which form the mark begin with the letter "L" is required to cause purchasers to miss the merely descriptive significance of the term "LEAN" or consider the entire mark to be a unitary expression. **In re Lean Line, Inc.**, 229 USPQ 781 (TTAB 1986)

We find that the situation here is akin to that in the Lean Line case, and accordingly we affirm the requirement for a disclaimer of PEST PROTECTION, and the refusal to register the mark in the absence of such a disclaimer.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key

considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's mark is PERIMETER PEST PROTECTION, while the cited mark is PERIMETER. Although marks must be compared in their entireties, it is well-established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Thus, although we certainly have considered the presence of the words PEST PROTECTION in applicant's mark, because they describe the nature of applicant's services we give greater weight to the first word of applicant's mark, the word PERIMETER.

Obviously the dominant word of applicant's mark is identical to the cited mark. Although, as applicant points out, the additional words in applicant's mark result in applicant's mark consisting of three words and eight syllables while the cited mark is one word and four syllables, these are distinctions without a difference. It is the word PERIMETER in applicant's mark which has the source-identifying significance, and it is this word that will make the strongest impression on purchasers. They are

likely to attribute the differences in the marks not to differences in the source of the products and services, but to the differences in the products and services themselves. That is, they are likely to believe that the same party which sells insecticides under the mark PERIMETER has varied that mark, when using it for pest control services, to PERIMETER PEST PROTECTION.

Things brings us to a consideration of applicant's services vis-à-vis the goods of the cited registration. To support a holding of likelihood of confusion, it is not necessary that the goods or services of the parties be similar or competitive or even that they move in the same channels of trade. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **In re International Telephone and Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

There is an obvious relationship between insecticides and insect and pest control. Consumers would be well aware



of this connection, i.e., that those offering insect control services use insecticides. The excerpts of articles taken from the NEXIS database, made of record by the Examining Attorney, support this conclusion. See, for example:

Many of the more effective insecticides are unavailable to homeowners because they are too costly or the size of the available container that has to be purchased is too large. Homeowners who feel they need these kinds of insecticides are advised to contact a Pest Control Operator who has the license and know-how to use these tools.

"Press Journal," (Vero Beach, FL  
(February 15, 2001)

A pest-control specialist will spray insecticide throughout the nursery once the wind dies down....

"The San Francisco Chronicle," June 23,  
2000

Under the agreement, commercial pest-control or lawn-care companies won't be able to use the insecticide.

Larger pest-control companies, such as Orkin, Terminex and Truly Nolen, already have shed Drusban as an exterminating tool.

Truly Nolen dropped it more than two years ago because of hazards posed by the insecticide....

"Sun-Sentinel," (Fort Lauderdale, FL),  
June 9, 2000

EPA officials are pressing Dow to withdraw the insecticide from all home, garden and commercial pest-control use....

"The Patriot Ledger" (Quincy, MA),  
June 3, 2000

Jack Huston of Catseye Pest Control  
applies an insecticide inside a Hudson  
home Tuesday after the homeowner  
spotted some carpenter ants.  
"The Times Union," (Albany, NY),  
June 28, 2000

You mention a pest control company. If  
you are having routine applications of  
insecticides....  
"The Detroit News," April 8, 2000

Given this relationship between applicant's services  
and the registrant's identified goods,<sup>4</sup> and the near  
identity of the marks, we find that consumers are likely to  
believe that applicant's PERIMETER PEST PROTECTION services  
and the registrant's PERIMETER goods emanate from the same  
source. Supporting this finding is the fact that  
applicant's services and the registrant's goods, as  
identified, are products and services offered to the  
general public, who would not be sophisticated purchasers.

In reaching this conclusion we have considered  
applicant's argument that the registrant's mark is  
suggestive and not a strong mark, and is therefore not

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<sup>4</sup> In our consideration of applicant's services we have not  
accepted the Examining Attorney's speculation that the services  
would include "offering advice and direction to homeowners about  
what types of insecticides to use." Brief, p. 12. Those  
services are not encompassed by applicant's identification, and  
our determination of likelihood of confusion must be based on the  
goods and/or services as they are identified in applicant's  
application and the cited registration.

entitled to a broad scope of protection. The Examining Attorney does not dispute the suggestiveness of the marks. However, even if we assume that they are suggestive, they both suggest the same thing, and therefore the marks have the same connotation. The commercial impressions they make are accordingly similar. There is no evidence of third-party use of PERIMETER marks, and therefore we cannot assume that the public is so familiar with such marks that they would look to the descriptive term PEST PROTECTION in applicant's mark as a means of distinguishing applicant's mark from the registrant's.

Applicant has also asserted that there is no evidence of actual confusion despite contemporaneous use since 1994. There are several problems with this argument, most notably that we have not heard from the registrant, so we have no information as to whether it has experienced any instances of actual confusion. In addition, during the prosecution of its application applicant stated that the registrant markets its goods only to professionals. This may explain the lack of instances of actual confusion, although we may not rely on this assertion to find no likelihood of confusion. The registration is not restricted to sales to professionals, and therefore registrant's rights extend to marketing its goods to the general public as well.

Finally, in reaching our decision we have not relied on the third-party registrations made of record by the Examining Attorney. The Examining Attorney has not discussed these registrations in his brief, and it appears that he has accepted applicant's criticisms of them.

Decision: The refusal of registration on the ground of likelihood of confusion is affirmed. The refusal of registration absent a disclaimer of PEST PROTECTION is also affirmed, although if applicant submits the required disclaimer within thirty days, this portion of the decision will be set aside.